

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

LUCKY BREAK WISHBONE
CORPORATION,

Plaintiff,

v.

SEARS, ROEBUCK AND CO., a New York
corporation, and YOUNG AND RUBICAM
INC., a Delaware corporation,

Defendants.

No. C06-312Z

ORDER

The Court *sua sponte* raised the issue of subject matter jurisdiction regarding Lucky Break's copyright claim in the prototype wishbone. Order, docket no. 140, at 22 n.10. Having now reviewed supplemental briefing on the issue, docket nos. 145 and 146, the Court concludes that it lacks subject matter jurisdiction over Lucky Break's copyright infringement claim in the prototype wishbone, for the reasons outlined herein.

"[N]o action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a). "Copyright registration is not a prerequisite to a valid copyright, but it is a prerequisite to a suit based on a copyright." Kodadek v. MTV Networks, Inc., 152 F.3d 1209, 1211 (9th Cir. 1998). "In order to obtain a copyright

1 registration, an applicant must deposit as part of his application a ‘copy’ or ‘copies’ of the
2 work.” Id. (citing 17 U.S.C. § 408(b)(1) and (2)). “[T]he registration deposit requirement
3 permits ‘bona fide copies of the original work only.’” Id. (quoting Seiler v. Lucasfilm, Ltd.,
4 808 F.2d 1316, 1322 (9th Cir. 1986)). “This means that any ‘copy’ deposited as part of an
5 application for a certificate of copyright registration must be virtually identical to the original
6 and must have been produced by directly referring to the original.” Id. at 1212; see also
7 Coles v. Wonder, 283 F.3d 798, 802 (6th Cir. 2002) (holding that there is no valid copyright
8 registration in an original work where a plaintiff did not refer to the original work in
9 producing the work that was deposited with the copyright application). In Kodadek, the
10 Ninth Circuit held that 1993 drawings that were made from an artist’s memory of 1991
11 drawings “are merely ‘reconstructions’ and not appropriate ‘copies’ of the 1991 drawings for
12 purposes of obtaining a valid certificate of copyright registration,” and explained its holding
13 as follows:

14 Kodadek asserts that he was so familiar with his 1991 drawings that he was
15 able to draw virtually identical copies of them two years later from memory.
16 While it may be possible for an artist to accurately reproduce his or her
17 previous work from memory, for the purpose of certainty in obtaining
18 copyright registration, such reproductions are simply insufficient.

19 Kodadek, 152 F.3d at 1212. Without a valid copyright registration in the 1991 drawings, the
20 Ninth Circuit concluded that the plaintiff’s infringement action was foreclosed. Id.

21 Here, Lucky Break’s copyright infringement claim alleges that Sears had access to
22 and copied Lucky Break’s prototype wishbone. However, Lucky Break deposited a copy of
23 only the production wishbone, and not the prototype wishbone, with the U.S. Copyright
24 Office in connection with its application for copyright registration. Thus, under Kodadek,
25 the Court must determine whether the production wishbone is virtually identical to the
26 prototype wishbone *and* whether the production wishbone was produced by directly referring

1 to the prototype wishbone, in order to conclude that Lucky Break has a valid copyright
2 registration in the prototype wishbone.¹

3 There are factual disputes as to whether the prototype and production wishbones are
4 “virtually identical.” The Court does not need to reach this issue because Lucky Break has
5 failed to provide any evidence that Mr. Hillesland produced the production wishbone by
6 directly referring to the prototype wishbone. As discussed in the Court’s Order of December
7 4, 2007, the prototype wishbone mold was completed in January 2004, whereas the
8 production wishbone mold was not completed until the end of September 2005. See Order at
9 4-5. Mr. Hillesland testified in his deposition that he could not remember whether he had the
10 prototype mold in front of him when he made the production mold. See Order at 6 (quoting
11 Rachman Decl., docket no. 92, Ex. 4 (Hillesland Dep.) at 42:8-11, “Q: So how did you – did
12 you have the prototype mold in front of you when you made the changes to the graphite on
13 the production mold? A: I don’t remember.”).

14 Lucky Break argues that “Lucky Break’s production wishbone was undisputedly
15 based on its prototype.” Pl.’s Suppl. Brief, docket no. 145, at 2. In support, Lucky Break
16 asserts that “[t]he very term ‘prototype’ assumes that it served as the original model on
17 which the production bone was based or formed.” Id. at 2 n.1. The “prototype” label is not
18 evidence that Mr. Hillesland directly referred to the prototype graphite electrodes, prototype
19 mold, or prototype wishbone when he created the production mold. Lucky Break also argues
20 that there is no evidence that Mr. Hillesland created the production wishbone solely from his
21 memory. Id. at 5. Lucky Break asserts that “a simple comparison of the two bones in
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23 ¹ The Court disagrees with Lucky Break’s argument that the “reconstruction cases” of
24 Kodadek and Seiler are limited to cases involving fraud, i.e., where the original works were lost
25 or destroyed. Pl.’s Suppl. Brief at 5 (citing Data East USA v. Epyx, Inc., 862 F.2d 204, 207 (9th
26 Cir. 1988)). It is true that the originals were unavailable in Kodadek and Seiler; however, this
distinguishing fact does not preclude the Court from requiring a bona fide copy of a work to be
deposited with the registration application. The Court also disagrees with Lucky Break’s
argument that Three Boys Music Corporation v. Michael Bolton, 212 F.3d 477 (9th Cir. 2000)
applies to the present case. Three Boys does not address the bona fide copy issue.

1 evidence confirms that he accomplished what he set out to do: deliver the ‘same look’ to Ken
2 Ahroni that was first embodied in the prototype.” Id. (quoting Hillesland Decl., docket no.
3 108, ¶ 12). Whether Mr. Hillesland delivered the “same look” does not address the issue of
4 whether Mr. Hillesland directly referred to the prototype graphite electrodes, prototype mold,
5 or prototype wishbone when he created the production mold. Lucky Break also relies on Mr.
6 Hillesland’s Declaration, at Paragraph 12, as evidence that Mr. Hillesland used the same data
7 set, chose the same cutter paths, and made the same manual alterations to the electrodes in
8 making the production mold as the prototype mold. Even if true,² these “facts” do not
9 provide any evidence that Mr. Hillesland directly referred to the prototype mold when
10 making the production mold. Mr. Hillesland could have attempted to make the same manual
11 alterations to the production graphite electrodes from his memory of what he did to the
12 prototype graphite electrodes. Because Lucky Break has submitted no evidence that Mr.
13 Hillesland referred to the prototype graphite electrodes, mold, or wishbone when he created
14 the production wishbone mold, the Court is left to speculate as to Mr. Hillesland’s process.

15 In the absence of any evidence that Mr. Hillesland directly referred to the prototype
16 graphite electrodes, mold or wishbone when he created the production wishbone mold, the
17 Court concludes that the production wishbone deposit was not a bona fide copy of the
18 prototype wishbone.³ Accordingly, Lucky Break lacks a valid copyright registration in the
19 prototype wishbone, and cannot maintain an infringement action thereupon. See 17 U.S.C.

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22 ² As noted in the Court’s Order of December 4, 2007, Mr. Hillesland also testified in his
23 deposition that there could be some variation between the manual alterations that he made to the
24 graphite electrodes for the prototype mold as compared to the manual alterations that he made
25 to the graphite electrodes for the production mold. Order at 6-7.

26 ³ The parties have not requested an evidentiary hearing. Nonetheless, the Court has
considered whether an evidentiary hearing is necessary to assist the Court in determining
whether the production wishbone is a bona fide copy of the prototype wishbone. Because
Plaintiff has submitted no evidence that Mr. Hillesland directly referred to the prototype mold
when creating the production mold, the Court concludes that an evidentiary hearing is not
warranted.

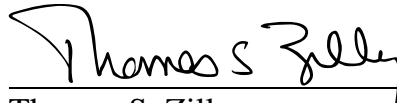
1 § 411(a). The Court does not have jurisdiction over Lucky Break's copyright infringement
2 claim in the prototype wishbone.

3 The Court advises the parties that it will dismiss Lucky Break's copyright
4 infringement claim in the prototype wishbone, see Second Am. Compl. ¶¶ 29-30, without
5 prejudice, unless Lucky Break supplements its registration pursuant to 17 U.S.C. § 408(d) or
6 registers the prototype wishbone with the U.S. Copyright Office within thirty days of the
7 entry of this Order. The Court directs Lucky Break to file a joint status report by **Friday,**
8 **January 25, 2008** regarding its copyright infringement claim in the prototype wishbone.

9 The parties are advised to submit a joint status report by **noon on Thursday,**
10 **December 20, 2007**, outlining their respective positions on whether the parties can be
11 prepared to go to trial on Monday, February 25, 2008, or whether the Court should stay the
12 case, in light of the above ruling.

13 IT IS SO ORDERED.

14 DATED this 18th day of December, 2007.

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17 Thomas S. Zilly
18 United States District Judge
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